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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,165	06/08/2005	Hiroyuki Hidaka	81887.0124	9232
26/021 7590 11/12/2008 HOGAN & HARTSON LLP. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067			EXAMINER SANTILAGO CORDERO, MARIVELISSE	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 11/12/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,165

Applicant(s)

HIDAKA, HIROYUKI

ExaminerMARIVELISSE SANTIAGO-
CORDERO**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 4, 7 and 8 is/are pending in the application.
4a) Of the above claim(s) 1, 2, 5, 6, 9 and 10 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 3, 4, 7 and 8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03 October 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 10/3/2008 have been fully considered but they are not persuasive.

Regarding the drawings, Applicant argues that Figure 3C is not prior art because Figure 3C is an example of a case in which the guard time is not set (Remarks: page 8, under "Drawings"). In response, the Examiner respectfully disagrees. Applicant's specification (page 7), under the "Brief Description of the Drawings" section, clearly stipulates that "Figs. 3A to 3C are timing charts showing processing performed in the 1xEVDO system during a **conventional** suspend time", thus, considered an admission or prior art. Consequently, Figure 3C should be labeled with --Prior Art-- because only that which is old is illustrated.

Regarding claims 3 and 4 under 35 U.S.C 102(a), Applicant argues that Applicant's Admitted Prior Art (AAPA) fails to teach or suggest that "the setting section does not set the suspend time after communicating with the base station by the second changing section", because Fig. 3c is not Prior Art. In response, the Examiner respectfully disagrees. Applicant's specification (page 7), under the "Brief Description of the Drawings" section, clearly stipulates that "Figs. 3A to 3C are timing charts showing processing performed in the 1xEVDO system during a **conventional** suspend time", thus, considered an admission or prior art.

Furthermore, Applicant argues that the statement in page 7, lines 6-7 of the Office Action, stating that "AAPA fails to specifically disclose after communicating with the base station by the second changing section" is inconsistent with the rejection over AAPA (Remarks: page 11, 2nd – 3rd full paragraphs). In response, the Examiner respectfully disagrees. At the

outset, it is noted that the features upon which applicant relies (i.e., **after** communicating with the base station by the second changing section) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, it is noted that the claim is directed to an apparatus. As stated in the last Office Action, regarding the 102 rejection over AAPA, in accordance with MPEP 2114, apparatus claims must be structurally distinguishable from the prior art (See page 5 of last Office Action). While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431- 32 (Fed. Cir. 1997); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). MPEP 2114 further states that the manner of operating the device does not differentiate apparatus claim from the prior art. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Therefore, given that apparatus claims must be structurally distinguishable from the prior art, the functional language "in a case of communicating with the base station by the second changing section" does not serve to distinguish, reason for doing the 35 USC 102

rejection. Nevertheless, although not required in apparatus claims, in order to also cover the functional language provided in the claim, the Examiner considered the limitation in the 103 rejection over AAPA in view of Turner.

Regarding the 35 U.S.C 103(a) rejection over AAPA in view of Turner, Applicant argues that Turner fails to teach or suggest the limitation “wherein the setting section does not set the suspend time after communicating with the base station by the second changing section” (Remarks: page 12, 1st full paragraphs). In response, the Examiner respectfully disagrees. Turner discloses in paragraphs [0098]-[0101] that while the terminal is communicating with the base station (the claimed after communicating with the base station by the second changing section) (i.e., when data packets are being exchanged) dormancy is not detected and the dormancy timer (i.e., the suspend timer) is not set.

Applicant further argues that in contrast to Turner, the “suspend time” of the present invention is a time in which the “first communication protocol” is usable and therefore, the “dormancy timer” of Turner is different from the “suspend time” of the present invention (Remarks: page 12, 2nd -3rd full paragraphs). In response, the claim does not uniquely and particularly define the term “suspend time” so as to distinguish from the applied art. During patent examination, the claims must be given their broadest reasonable interpretation. See MPEP 2111. Broadly interpreted, a suspend time and a dormant time can fairly be characterized as a time where activities are stopped.

Drawings

2. Figure 3C should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (See *Response to Arguments* section above). See MPEP § 608.02(g).

Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 3 and 4 rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's Admitted Prior Art (hereinafter "AAPA").

Regarding claim 3, AAPA discloses a wireless communication terminal (Background Art: page 1, line 25 through page 2, line 7), which performs wireless communication using each of a first communication protocol and a second communication protocol (Background Art: page 1, line 25 through page 2, line 7) and enables to be in an idle state with both protocol (Background Art: page 2, lines 17-24), comprising:

a setting section that sets a suspend time for detecting an incoming call from a base station using the first communication protocol subsequent to completion of communication with the base station using the first communication protocol (Background Art: page 3, lines 4-11;

page 12, lines 15-25; note that this section constitute an admitted prior art statement since only that which is old and/or known is disclosed);

a first changing section that changes a monitoring timing of the second communication protocol (Background Art: page 2, lines 8-21; page 16, line 20 through page 17, line 3); and

a second changing section that changes a monitoring timing of the first communication protocol by communicating with the base station when the first changing section changes the monitoring timing of the second communication protocol (Background Art: page 2, lines 8-21; page 16, line 20 through page 17, line 3),

wherein the setting section does not set the suspend time (Fig. 3C; page 14, lines 11-12; note that this section constitute an admitted prior art statement since only that which is old and/or known is disclosed) after communicating with the base station by the second changing section.

In accordance with MPEP 2114, apparatus claims must be structurally distinguishable from the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “Apparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

MPEP 2114 further states that the manner of operating the device does not differentiate apparatus claim from the prior art. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)

Regarding claim 4, AAPA discloses wherein the first communication protocol is a 1x Evolution Data Only system, and the second communication protocol is a Code Division Multiple Access 2000 1x system (Background Art: page 1, line 25 through page 2, line 7).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (hereinafter "AAPA") in view of Turner (Pub. No.: US 2003/0152049).

Regarding claim 3, AAPA discloses a wireless communication terminal (Background Art: page 1, line 25 through page 2, line 7), which performs wireless communication using each of a first communication protocol and a second communication protocol (Background Art: page 1, line 25 through page 2, line 7) and enables to be in an idle state with both protocol (Background Art: page 2, lines 17-24), comprising:

a setting section that sets a suspend time for detecting an incoming call from a base station using the first communication protocol subsequent to completion of communication with the base station using the first communication protocol (Background Art: page 3, lines 4-11;

page 12, lines 15-25; note that this section constitute an admitted prior art statement since only that which is old and/or known is disclosed);

a first changing section that changes a monitoring timing of the second communication protocol (Background Art: page 2, lines 8-21; page 16, line 20 through page 17, line 3); and

a second changing section that changes a monitoring timing of the first communication protocol by communicating with the base station when the first changing section changes the monitoring timing of the second communication protocol (Background Art: page 2, lines 8-21; page 16, line 20 through page 17, line 3),

wherein the setting section does not set the suspend time (Fig. 3C; page 14, lines 11-12; note that this section constitute an admitted prior art statement since only that which is old and/or known is disclosed).

AAPA fails to specifically disclose after communicating with the base station by the second changing section (See *Response to Arguments* section above).

However, in the same field of endeavor, Turner discloses a wireless communication terminal (Fig. 2; Abstract; note the hybrid access terminal), which performs wireless communication using each of a first communication protocol and a second communication protocol (Abstract) and enables to be in an idle state with both protocol (paragraphs [0057]-[0064]), comprising:

a setting section that sets a suspend time (Fig. 2, reference 214)

wherein the setting section does not set the suspend time after communicating with the base station by the second changing section (paragraphs [0098]-[0101]; note that while the

terminal is communicating with the base station (i.e., when data packets are being exchanged) dormancy is not detected and the dormancy timer (i.e., the suspend timer) is not set).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant not to set the suspend time of AAPA after communicating with the base station by the second changing section as suggested by Turner for the advantages of receiving incoming pages at all times when not active (Turner: paragraph [0149]), maintaining communication resources available, and enabling network operators to develop an accurate picture of true network performance.

Regarding claim 4, in the obvious combination, AAPA discloses wherein the first communication protocol is a 1x Evolution Data Only system, and the second communication protocol is a Code Division Multiple Access 2000 1x system (Background Art: page 1, line 25 through page 2, line 7).

Regarding claims 7-8, which recites a method version of claim 3, see rationale as discussed above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIVELISSE SANTIAGO-CORDERO whose telephone number is (571)272-7839. The examiner can normally be reached on Monday through Friday from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent P. Harper can be reached on (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/
Supervisory Patent Examiner, Art Unit 2617

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